

REMARKS/ARGUMENTS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1, 2, 6-8, and 10 are pending in the present application, Claims 1, 2, 6-8, and 10 having been amended and Claims 3-5, 9, and 11-15 having been canceled by the present amendment. Claims 1, 6-8, and 10 are rewritten to more clearly describe and distinctly claim the subject matter that Applicants regard as the invention without adding new matter. Support for the amendment to Claim 2 is found in the Specification at paragraph [0044], for example, and therefore no new matter is added.

In the outstanding Official Action, Claims 1-15 were rejected under 35 U.S.C. §103(a) as unpatentable over Dziewit et al. (U.S. Patent No. 4,981,370, hereinafter Dziewit) in view of Graziano et al. (U.S. Patent No. 5,191,613, hereinafter Graziano).

Applicants respectfully traverse the outstanding ground of rejection because the outstanding Office Action fails to provide a *prima facie* case of obviousness by asserting prior art that, no matter how the prior art references are combined, does not teach every element of independent Claims 1 and 10, as amended.

To establish a *prima facie* case of obviousness, M.P.E.P. §2143 requires that three criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the references teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim elements.

Amended Claim 1 is directed to

an electronic contract safekeeping method, comprising:

displaying a contractual coverage of a contract at a covenantee terminal connected to a contractor server storing information of the contractual coverage;

inputting contract agreement information representing whether agreeing to the contractual coverage or not, at the covenantee terminal;

inputting safekeeping agreement information representing whether agreeing to a safekeeping of the contractual coverage or not, at the covenantee terminal, when the contract agreement information agreeing to the contractual coverage is inputted;

requesting a contract safekeeping server to store the contractual coverage, when the safekeeping agreement information agreeing to the safekeeping is inputted;

issuing a contract ID for identifying the contract at the contract safekeeping server in accordance with the request; and

transferring the issued contract ID from the contract safekeeping server to the covenantee terminal and the contractor server.

This method allows for confirmation of the contractual coverage, even if the contractual coverage is deleted in from the contract server.¹

The combination of Dzeiwit and Graziano do not teach or suggest the claimed “requesting a contract safekeeping server to store the contractual coverage, when the safekeeping agreement information agreeing to the safekeeping is inputted.”

On the contrary, Dzeiwit and Graziano only describe using a third party fiduciary, such as a bank, as a repository for the document.² The use of bank does not teach or suggest “requesting a contract safekeeping server to store the contractual coverage, when the safekeeping agreement information agreeing to the safekeeping is inputted.”

In addition, the combination of Dzeiwit and Graziano in no way teaches or suggests the following elements of amended Claim 1:

inputting contract agreement information representing whether agreeing to the contractual coverage or not, at the covenantee terminal,

¹ Specification, paragraph [0007].

² Dzeiwit, col. 13, lines 14-18, and Graziano, col. 14, lines 34-41.

and

inputting safekeeping agreement information representing whether agreeing to a safekeeping of the contractual coverage or nor, at the coventantee terminal, when the contract agreement information agreeing to the contractual coverage is inputted.

The editing of a file shown in Fig. 3, the entry of a login, and the entry of an electronic signature does not teach or suggest the above-noted elements.

Furthermore, the outstanding Office Action suggests that the document authentication described in the cited references is “functionally equivalent” to the claimed invention.³ However, there is no explanation in the prior art that teaches that the described document authentication of the cited references and the claimed invention are functional equivalents, and M.P.E.P. 2144.06 requires such prior art equivalency recognition, citing In re Ruff, 256 F.2d 590, 118 USPQ 340 (CCPA 1958).

In view of the above-noted distinctions, Applicants respectfully submit that Claim 1 (and dependent Claims 2 and 6-8) patentably distinguish over the combination of Dziewit and Graziano. Applicants respectfully submit that Claim 10 patentably distinguishes over the combination of Dziewit and Graziano for at least the reasons stated for Claim 1.

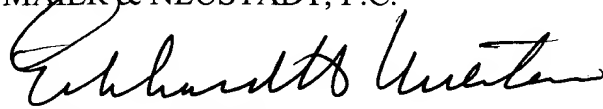
³ Office Action, page 2.

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Consequently, in light of the above discussion and in view of the present amendment, the present application is believed to be in condition for allowance and an early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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